

**REMARKS/ARGUMENTS**

**I. The Office Action and Claim Amendments**

In the above-mentioned Office Action, claims 140, 141, 142, 148, 156, 157, 164, 171, 177, 182, 183, 184, 190, 198, 199, 205, 214, 217, 222 and 223 were rejected under 35 U.S.C. 102(b) as being anticipated by Capozzola; claims 140, 141, 142, 144, 148, 156, 157, 160, 164, 171, 182, 183, 184, 186, 190, 198, 199, 202, 205, 214, 222 and 223 were rejected under 35 U.S.C. 103(b) as being anticipated by Kennedy, Jr.; claims 143, 146, 149-152, 158, 159, 178, 185, 188, 191-194, 200, 201 and 218 were rejected under 35 U.S.C. 103(a) as being anticipated by Kennedy, Jr. in view of Popat, et al.; claims 145, 161, 180, 187, 203 and 220 were rejected as being unpatentable over Kennedy, Jr. in view of Carlson; 147, 153-155, 163, 179 and 181 were rejected as being unpatentable over Kennedy, Jr. in view of Cross; claims 172-174 and 212-213 were rejected as being unpatentable over Kennedy, Jr. in view of Klein; claims 175, 176, 215 and 216 were rejected as being unpatentable over Kennedy, Jr. in view of Hickenbotham, et al.; claims 140, 165, 182 and 206 were rejected as being unpatentable over Casagrande in view of Marschke; and claims 169, 170, 210 and 211 were rejected as being unpatentable over Casagrande in view of Marschke, and further in view of Hickenbotham, et al.

Claims 224-226 were allowed, and the allowance thereof is acknowledged with appreciation.

Allowable dependent claims 166-167 and 207-209 have been rewritten as independent claims. They are thus in condition for allowance.

Claims 140-165, 169-206 and 210-223 have been cancelled without prejudice or disclaimer.

New claims 227-275 have been added, and include independent claim 227 whose patentability is explained below.

II. Ultraremovable Adhesive

Claim 227 includes an "ultraremovable adhesive." It is stated on page 9 of the present application that "ultraremovable adhesives" stick to the paper allowing easy removable and disposal. Even though they are tacky, they do not stick to anything permanently. Generally adhesions of ultraremovable adhesives at their highest adhesion levels (to a surface such as stainless steel) are roughly half of what they are for conventional "removable" adhesives. A fundamental difference is that conventional adhesives provide complete contact with the substrate while ultraremovable adhesives provide partial contact. This limited contact is what prevents an ultraremovable adhesive from becoming permanent, over time. Also, at page 25 it states that the preferred ultraremovable adhesive can be "the FASSON water-base acrylic suspension polymer (made per U.S. Patent 5,656,705) or the CleanTac II adhesive available from Moore."

Additionally, the term "ultraremovable adhesive" is used in the art and two examples follow. U.S. Patent No. 4,548,845 (Parsons et al.) states that an "ultra-removable adhesive can be expected to have a 90 degree peel adhesion value of about 0.05 pounds per inch of test sample width, a loop tack value of about 0.1 pounds per inch of test sample width and a shear value of about one minute using a 250 gram weight."

Attached is an article from *Converting Magazine* December 2000, entitled "Analytical Methods Optimize Ultraremoveables." It says in part that "[u]ltraremovable pressure sensitive adhesives can be defined as products which do not build up or gain peel adhesion over time and are clearly removable from the substrate."

III. "Dimensioned, constructed and adapted to" Imparts Structural Claim Limitations

New independent claim 227 uses the phrase "adapted to" (or more particularly, "dimensioned, constructed and adapted to") three times. While it is true that a statement of intended use in a preamble of a claim may impart no structural limitations,

the descriptive phrase "adapted to" in a claim body imparts structural limitations. In fact, as a matter of law, language in the body of a claim following the descriptive phrase "adapted to" is a structural limitation, and must be considered in a patentability determination. For example, in In re Venezia, 530 F.2d 956, 957, 189 USPQ 149, 150 (CCPA 1976), some of the claim language at issue was "a pair of sleeves of elastomeric material ... adapted to be fitted over the insulating jacket of one of said cables." Concerning the above-quoted aspect of the claim, the Court of Customs and Patent Appeals stated that "rather than being a mere direction of activities to take place in the future, this language imparts a structural limitation to the sleeve. Each sleeve is so structured and dimensioned that it can be fitted over the insulating jacket of the cable." Id. at 959, 189 USPQ at 151-152, emphasis added. (See also In re Barr, 444 F.2d 588, 170 USPQ 330 (CCPA 1971).)

It is also well settled that all claim limitations must be considered and that it is improper for an examiner to ignore specific limitations that distinguish over the cited references. See, e.g., In re Boe and Duke, 505 F.2d 1297, 1299, 184 USPQ 38, 40 (CCPA 1974).

#### IV. Claim 137 is Patentable Over the Prior Art

Brief discussions of why new independent claim 137 is not disclosed in any of the three primary references (Capozzola, Kennedy and Casagrande) follow.

Capozzola discloses the use of a permanent adhesive and not an ultraremovable adhesive. Further, one would not want to replace the permanent adhesive with an ultraremovable adhesive because then the tag which is affixed to the inside of the user's shoe would tend to loosen and fall off, especially under the movement, pressure, heat and moisture of the user's foot.

Kennedy does not disclose the use of ultraremovable adhesive. Kennedy also does not disclose a printable business card sheet which is "dimensioned, constructed and adapted to be sheet-fed through a printer or copier for a printing operation on the printable business cards." Rather, Kennedy shows a narrow strip of tags adapted for

PATENT  
Old Docket No. 310048-550  
Docket: 11286-1115  
Avery No. 2991-US

tractor feeding (see FIG. 1). More particularly, it discloses a roll or fan-fold type of construction, which is not "dimensioned, constructed or adapted to" be sheet-fed. The liner sheet also is not "solid," but has holes. Kennedy additionally does not disclose the limitations in the last and next to last paragraphs of claim 227, including the structural relationships between the printable business cards and the matrix waste portion.

Casagrande shows a multi-layer lamination of translucent paper or film, thin cast film and paper. It does not disclose the cardstock sheet construction and the carrier sheet as claimed. It also does not disclose back sides of the cardstock sheet construction forming back side surfaces of printable business cards. It further does not disclose ultraremovable adhesive.

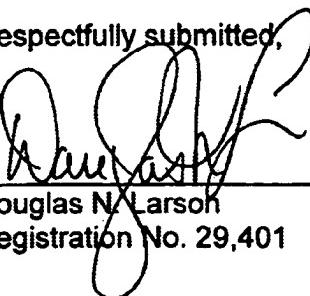
#### V. Concluding Remarks

Accordingly, it is respectfully contended that all of the claims now pending are patentable over the prior art of record. Thus, issuance of the Notice of Allowance at an early date is in order.

If there are any remaining issues, the Examiner is encouraged to telephone the below-signed counsel at (213) 689-5142 to seek to resolve them.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 07-1853. Should such additional fees be associated with an extension of time, Applicants respectfully request that this paper be considered a petition therefor.

Respectfully submitted,



Douglas N. Larson  
Registration No. 29,401

Dated: November 2, 2004

SQUIRE, SANDERS & DEMPSEY L.L.P.  
801 South Figueroa Street, 14th Floor  
Los Angeles, California 90017-5554  
Telephone: (213) 624-2500  
Facsimile: (213) 623-4581